



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/460,556	12/14/1999	ELWYN B. DAVIES	NTL-3.2.108/	2619
26345	7590	12/02/2003	EXAMINER	
GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE 1 RIVERFRONT PLAZA NEWARK, NJ 07102-5497			HARRELL, ROBERT B	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/460,556

Applicant(s)

DAVIES ET AL.

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Serial Number: 09/460,556
Art Unit : 2142

1. Claims 1-17 remain for examination.
2. Each claim must be one sentence long starting with a capital letter and ending with a period. Thus use of capital letters between the first letter and the period must be made into a lower case (eg., claim 1 (line 5 "A" should be --a--)).
3. The Title is still not descriptive of the claimed invention.
The invention is more directed to --A System Indicating The Presence Of an Individual Or Groups Of Individuals--.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or
5. Claims 1-17 are rejected under 35 U.S.C. 102 (e) as being anticipated by Cuomo et al. (6,148,328).
6. The grounds for rejecting the claims, as presented in

Serial Number: 09/460,556
Art Unit : 2142

examiner's prior action (paper #6 (mailed 6/19/03 (Paragraph 3-18))) continue in this action and are hereby incorporated by reference. The newly added limitations will be addressed below.

7. The applicant argued the above cited rejection, filed 9/18/03 (paper #7)), in substance by stating:

- a) the independent claims have been amended to recite that the watching and watched parties are "connected to the presence management systems". However, per figure 1 and col. 3 (lines 18-29) software program code which employs Cuomo present invention is typically stored in the memory of "a" storage device 14 of a single stand alone workstation or LAN "server" for distribution. Thus the presence management system of Cuomo could be either run on a single Server or dispersed throughout the network. In either cases, in order for the presence management system can become aware of the presence or absence of one or more users, such a connection is inherently required and anticipated via a direct link or virtual channel. Thus for nay one or more users to have their presence monitored by the presence management system must be connected to the presence management system;
- b) Cuomo does not teach the features of "at least one of the parties comprising a plurality of individuals, wherein each

Serial Number: 09/460,556
Art Unit : 2142

individual has a respective connection to the presence management system". However, and first, it was stated in examiner's prior action (paragraph 4(b)) "Mary Zinger" of figure 3 (301) could have children who could partake in chat activities. It was well known to have more than one computer in a family home from which the children could partake in the chat activities over the Internet; each would thus require its own separate connection to the presence management system via the family Gateway (if all shared the same IP address (ie., Internet Account)) even though the whole household had one common IP address and domain name with user names wildcarded (ie., *@uspto.gov) or based on their electronic mail address (col. 3 (line 49)); and it was well known that one IP address could have more than one electronic mail address. Thus "Mary Zinger" (mary_zinger@some.provider.com) and a child (child_zinger@some.provider.com) would be in the watched group AT "some.provider.com". Furthermore, the applicant stated earlier in his response on page 7 (lines 19-20) that "Cuomo discloses a system either for alerting a target user to whether a selected "group" of other computer users are online or offline. [emphasis added]. Thus the applicant has stated Cuomo taught of watching a group (ie., the group is the watched party) and each individual in the group required a computer that was anticipated

Serial Number: 09/460,556
Art Unit : 2142

to be connected to the presence management system. Finally, in support of the applicant's argument, the applicant earlier stated on page 7 (lines 16-18) of his response "The reference to each said individual has a respective connect to the presence management system" is disclosed several time during the discussion of "Aggregates" on pages 21 to page 24 line 4 of the applicant's textual portion of his specification. However, Cuomo also taught of "Aggregates" in his Abstract (line 5), figure 2 (203), col. 3 (line 40), col. 7 (line 35) and elsewhere while col. 3 (lines 32-34) clearly taught an Arrival/Departure Channel 200 which signaled the arrival and departure of selected set of users. Thus a "set" was one of the watched parties and thus watched parties in Cuomo could be one or more individuals. All of these individuals inherently required a computer to gain access to the system and thus each of the individuals had to have a respective separate connection to the presence management system. Thus, in Cuomo, one group could watch another group and all individuals in each group inherently had to have a computer to partake in the watching/watched that was anticipated to be connected to the presence management system;

c) examiner uses the lively example of "Mary Zinger", shown in figure 3 as 301, having children who could partake in chat

Serial Number: 09/460,556
Art Unit : 2142

activities using a shared family computer. It is respectfully submitted that such a situation is not expressly taught in Cuomo. However, while Cuomo does not go to the details of the family use of his invention, it is well known that many families have children who too may wish to talk to Grandmother on their own computers along with their mother; and thus multiple computers in one family home was clearly anticipated. None the less, Cuomo taught "Aggregate" in one sense and a "set of users" in col. 3 (lines 30-42);

d) Cuomo does not teach a system in which a plurality of individuals can be regarded by the presence management system as a single watching or watched party, while each individual has a separate connection to the system. However, col. 3 (lines 32-35) states the use of a "set of users"; a set equates to a group or a plurality of individual users each having their own computer and connection to the system;

e) Cuomo did not teach "aggregate". However, see Abstract (line 5), figure 2 (203), and col. 3 (line 35-et seq.);

f) claim 12 has been amended to change "is" to --being-- and "limited" to --predetermined". However, these alteration do not change the context of the claim. Specifically, "is" the verb for third person singular present tense of be; of which is now

Serial Number: 09/460,556
Art Unit : 2142

claimed "being". Also, "limited time" and "predetermined time" each fences time into a specific duration. None the less, examiner's ground in paragraph 15, with respect to claim 12, still holds in that each computer requires an address to distinguish that computer from another and such address was anticipated to be operable for the predetermined time established by the connection.

8. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.

10. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuomo et al. (6,148,328).

11. All the reasons set forth above and in examiner prior action

Serial Number: 09/460,556
Art Unit : 2142

with respect to the claims as rejected under 35 U.S.C. 102(e) are hereby incorporated in this action as the grounds for rejecting the claims also under 35 U.S.C. 103; that which was anticipated was obvious. However, the applicant arguments and amendments warrants this follow up rejection to adjunct the above recited rejection. While Cuomo did teach a group of people could be a watched party, even in the void of such teaching as provided in the Abstract, figure 2, and col. 3 (line 30-et seq "set of users" and/or "Aggregate" and also as covered by the applicant in his response on page 7 (lines 19-20), it would have been obvious to lump a set of users of a special interest into a group because a user would then become aware when anyone of the users in the group became available as suggested and taught in col. 1 (lines 25-31), Obviously each individual, in a group or not, required a computer and a connection to the presence management system such that the user's presence could be registered by the presence management system. Finally, "a buddy list" is a group of users and thus the buddy list is a watched party having many individuals therein with their own computer and connection to the presence management system.

12. The changed scope of the claims necessitated a new search.

13. The applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL see MPEP 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of

Serial Number: 09/460,556
Art Unit : 2142

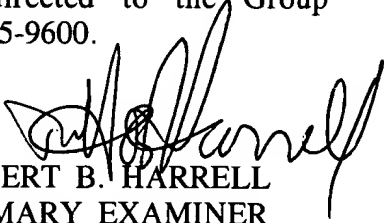
automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

14. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley, can be reached on (703) 308-5221. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142